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In re Application of
GREDLEY, Sarah
Application No.: 10/521,139
Filing Date: 12 January 2005
Attorney Docket No.: 006329.00005
For: PICTURE FRAME

DECISION ON PETITIONS
UNDER 37 CFR 1.137(b)
&
37 CFR 1.78

This decision is issued in response to applicant's "Renewed Request for Reconsideration - Renewed Petition under 37 CFR 1.137(b) to Revive an Unintentionally Abandoned Application" filed 06 June 2008 in the above-captioned application. Additionally, this decision is issued in response to applicant's "Petition (Conditional) under 37 CFR 1.78(a)(3) to Accept Late Claim of Priority" filed 06 March 2006 and applicant's Preliminary Amendment and Request for Priority Benefit filed 23 December 2009.

BACKGROUND

On 23 May 2003, applicant filed international application PCT/GB03/02228 which claimed a priority date of 23 May 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 23 November 2004.

On 12 January 2005, applicant filed, *inter alia*: a transmittal letter to the US Designated/Elected Office Concerning a Filing under 35 U.S.C. 371; an application containing a specification, including claims and drawings; a Fee transmittal for FY 2005; copy of the international application; a preliminary amendment for continuation of PCT/GB03/02228; an application data sheet; and the instant petition and fee to revive the international application as to the United States under 37 CFR 1.137(b). In a decision dated 04 January 2006, applicant petition under 37 CFR 1.137(b) was dismissed without prejudice. Further, applicant was notified that the submission would be treated under 35 U.S.C. 111, not 35 U.S.C. 371.

On 06 March 2006, applicant filed a "Renewed Petition under 37 CFR 1.137(b)" and "Petition (Conditional) under 37 CFR 1.78(a)(3) to Accept Late Claim of Priority." In a decision dated 09 August 2006, applicant petition under 37 CFR 1.137(b) was dismissed without prejudice.

On 09 November 2006, applicant filed a "Request for Reconsideration Renewed Petition under 37 CFR 1.137(b)." In a decision dated 06 March 2008, applicant petition under 37 CFR 1.137(b) was dismissed without prejudice.

On 06 June 2008, applicant filed a "Renewed Request for Reconsideration - Renewed Petition under 37 CFR 1.137(b) to Revive an Unintentionally Abandoned Application."

On 23 December 2009, applicant's filed a Preliminary Amendment and Request for Priority Benefit.

DISCUSSION

Petition to Revive under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that PCT/GB03/02228 be revived as to the United States on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Items (2) and (4) were previously satisfied.

Regarding item (1), applicant has supplied the proper reply in the form of the filing of a continuation application. Item (1) has been satisfied.

As to item (3), applicant's statement, in the petition papers dated 10 August 2005, that "the delay in filing this required reply from the due date for the action (November 23, 2004) until filing of this petition was unintentional" has been construed as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." **If this is an incorrect interpretation in view of the rules, Petitioner must immediately notify the Office of PCT Legal Administration of such error.** Thus, item (3) has been satisfied. Furthermore, the evidence of record is sufficient to establish that the instant application was not abandoned intentionally.

A review of the application file reveals that a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied.

Petition under 37 CFR 1.78

Additionally, this decision is in response to applicant's "Petition (Conditional) under 37 CFR 1.78(a)(3) to Accept Late Claim of Priority" dated 06 March 2006, requesting acceptance of an unintentionally delayed claim for priority under 35 U.S.C. 365(c) and 37 CFR 1.78(a)(3) to international application PCT/GB03/02228.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed international application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR § 1.78(a)(2)(ii). In addition, the petition under 37 CFR § 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR §1.78(a)(3) in that (1) a proper reference to the prior-filed application has been included in an application data sheet submitted on 23 December 2009, as provided by 37 CFR §1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §120 to the prior-filed application satisfies the conditions of 37 CFR § 1.78(a)(3), the petition is granted.

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.

CONCLUSION

For the reasons discussed above, applicant's petition to revive international application PCT/GB03/02228 is **GRANTED** and applicant's petition under 37 CFR 1.78 is **GRANTED**.

International application no. PCT/GB03/02228 is being revived for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of continuation application number 10/521,139.

Any questions concerning this matter may be directed to Anthony Smith at (571) 272-3296.

This application is being forwarded to the Office of Initial Patent Examination for further processing under 35 U.S.C. 111(a), including indicating in the Office records that the present application is a continuation application of international application no. PCT/GB03/02228.



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